

REMARKS/ARGUMENTS

In response to the Office Action dated January 7, 2005, claims 40, 46, 47 and 53 are amended. Claims 40-42, 45-49, 52 and 53 are now active in this application. No new matter has been added.

OBJECTION TO THE CLAIMS

Claim 40 is objected to because of the following informalities: Claim 40 recites “information indicative of a the identity of the promotion carrier” The claim should read as “information indicative of the identity of the promotion carrier”.

By this response, “a” is deleted from the recitation.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 40-42, 45-49, 52 and 53 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, the Examiner contends that a “reusable printed promotion carrier” is not described in the specification. However, the first full paragraph of page 21 of the application describes “The Reward Offer presents to the PPH at least one offer (and *preferably presents a plurality of such offers*) *for a sale of a product* (or for sale of a plurality of products) *identified in the Reward Offer*. ...Consequently, *the PPH* becomes motivated to bring its Reward Offer to the retail establishment which provided the Reward Offer and to *present the Reward Offer*

to a check-out station 20 at the establishment during a check-out transaction 70. (Emphasis Added)"

Thus, since the PPH presents the Reward Offer to a check-out station during a check-out and the Reward Offer preferably presents a plurality of offers for a sale of a product (a product means "a single product"), it is inherent that such Reward Offer is reusable in order that the PPH can take advantage of each of the plurality of offers for sale of the single product.

To expedite prosecution, claims 40 is amended to delineate, *inter alia*:

a printed promotion carrier which carries information corresponding to a plurality of promotions for sale of a product, the promotion carrier having a machine readable code thereon which identifies the promotion carrier and a respective specific customer identifier corresponding to the identified promotion carrier, the respective specific customer identifier corresponding to a specific customer pre-selected to receive the printed promotion carrier, each promotion being associated with a product, each product having a machine readable product code and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product;...

The above subject matter is supported by the first full paragraph of page 21 of the application and clearly delineates that the printed promotion carrier will be presented each time it is used for each of the plurality of promotions for sale of the (single) product (i.e., it is reusable).

Claim 47 is similarly amended.

In view of the above, withdrawal of the rejection of claims 40-42, 45-49, 52 and 53, as amended, under 35 U.S.C. §112, first paragraph, is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

I. Claims 40, 41, 46-48 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (USPN 5,995,942) in view of Day et al. (USPN 6,484,146) and further in view of Blank (USPN 5,531,482).

The Examiner acknowledges that Smith fails to teach a reusable printed promotion carrier and “the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading device, and the computer facility determines if there are valid promotions contained on the promotion carrier” and “the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction.” Blank is relied upon as disclosing a reusable printed promotion carrier (Figs. 3, 4b, 6b and column 5, lines 54-67) and Day et al. is relied upon to teach that a household may receive a reward offer and can take advantage of combined purchasing power (column 6, line 55-column 7, line 10). The Examiner maintains that it would have been obvious to a person of ordinary skill in the art to combine the references to meet the terms of the claims.

The rejections are respectfully traversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. §103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ

570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Smith et al. is quite specific about “Once the scanner 102 scans the savings sheet, a signal is sent via the communication lines to the network interface or computer 18 to identify the document and *to cancel the document so that it can not be used a second time*. (See column 7, lines 63-66). Given this disclosure, it is unrealistic to contend that one having ordinary skill in the art would somehow have been impelled to zero in on a reusable printed promotion carrier which the Examiner contends is taught by Blank and then apply this to the dispensed offer/savings sheet (Fig. 6) disclosed by Smith et al. which would not be consistent with the above-noted disclosure of Smith et al. In this regard, the Examiner should note that it is well settled that one having ordinary skill in the art can not be presumed motivated to modify a reference in a manner inconsistent with the disclosed function. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The only apparent motivation of record for the proposed modification of the dispensed offer/savings sheet (Fig. 6) disclosed by Smith et al. to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

Regarding the recitation “the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction”, as noted, the Examiner contends that Day et al. teaches “that a household may receive reward offer and can take advantage of combined purchasing power (column 6, line 55-column 7, line 10).” The Examiner then asserts “Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to identify promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once).”

However, this is not how Day et al. operates. It is described at column 5, lines 27-42 of Day et al.:

In operation, a customer sets up an account with a store and receives one of the cards 22. Then, *whenever the customer goes shopping, he or she goes to one of the kiosks before beginning shopping and presents the card 22 to the customer interface 28*. The store level computer 12 includes means for accessing information about the special offers available to the customer associated with the card, and generates a customized list of special offers available to that particular customer. More particularly, *the computer 12 determines what special offers are available to this customer, and sends a list of special offers to the offer communicator 32. The customer then has a shopping list of special offers to use while shopping*. The customer does not engage in any selection process, but instead is quickly processed at the kiosk. *The customer then has a limited time, e.g. 3 hours, to take advantage of the special offers before they expire.* (Emphasis Added)

It is further described at column 6, line 50 to column 7, line 10 of Day et al.:

After the customer finishes shopping, the customer presents his or her card 22 to the check-out 34, where the card 22 is scanned before or while purchases are rung up. The system 10 includes means for associating a purchased product with a customer account if one of the cards 22 is scanned by the bar code reader 36 in sequence with scanning of products.

More particularly, a list of all products for which special offers exist for at least one customer is downloaded from the store level computer to the check-out 34 at appropriate times, after special offer programs are initiated. *The check-out 34 then has a list of all products for which discounts may be available to certain customers. If a customer purchases a product which is included in this list, the check-out 34 communicates with the store level computer 12 to determine if a special offer is available to the particular customer whose card 22 was scanned by the check-out 34 in sequence with the products, and to determine the value of the special offer for this customer. The check-out 34 applies any special offers available to that customer to the customer's total if the customer purchased products for which special offers were available to the customer.* In one embodiment, if a product that is currently on promotion to at least one customer is scanned at the check-out 34 before the customer's card 22 is scanned, the check-out register 34 communicates the purchase to the store level computer 12 but does not necessarily wait for a response from the store level computer 12. If or when the customer card 22 is finally scanned at the check-out register 34 as part of the shopping trip, the check-out 34 communicates the card number of the customer card 22 to the store level computer 12. The store level computer 12 then communicates to the check-out register 34 each discount that the consumer qualified for because of the product purchases made in this shopping trip prior to the scan of the customer card 22. Subsequent discounts are then received by the check-out 34 immediately following the scan of a qualifying product, as previously presented.

Special offers that were accepted by the customer, and that are restricted to a certain quantity of product, will not be available to the customer the next time the customer accesses the kiosk 26 if the quantity limit has been reached. Thus, double couponing (where a customer uses the same coupon in different stores to avoid quantity limits) is avoided. The check-out sends to the computer 12 information regarding all purchases made by the customer.

Optionally, members of a household could be treated as a single customer, so that they can take advantage of combined purchasing power. The members of the household would then all have cards associating them with the same customer account in the computer 12. The computer 12 identifies which customers should be treated as a household, such as if two customers have the same address. Thus, the two customers that should belong to the same household can optionally be given the option of being treated as a household. Members of a same household may opt out of being treated as a single household. (Emphasis Added)

Thus, after a customer purchases a certain quantity of a product, double couponing is prevented by the store level computer preventing the kiosk 26 from including that product

on the dispensed *customer's shopping list of special offers to use while shopping* when the customer next accesses the kiosk for the list of special offers. This is different from "the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction. In Day et al., only valid special product offers are included on the customer's shopping list. Also, the customer's shopping list of special offers is never presented to a reading device for reading a machine readable code on the shopping list associated with each product having a special product offer. Also, as noted above with respect to Smith et al., "Once the scanner 102 scans the savings sheet, a signal is sent via the communication lines to the network interface or computer 18 to identify the document and *to cancel the document so that it can not be used a second time.*" More specifically, once the sheet (Fig. 6) of Smith et al. is used, it cannot be reused so that it is the sheet of promotions for the customer that is no longer valid, not a particular promotion associated with a particular product.

Thus, as noted in the previous response, neither Smith et al. nor Day et al., taken alone or in combination, disclose or suggest a system or a method of providing promotions in which it is determined if a detected promotion on the printed promotion carrier has already been presented, and the promotion is identified as a valid promotion if it has not already been presented.

As noted in the previous response, Day et al. discloses the use of a customer identification card to obtain the promotions. See, col. 4: 32-48. Also, Day et al. does not disclose or suggest to use a promotion carrier which bears a plurality of offers for sale of a plurality of promotions for sale of a product, the promotion carrier having a machine

readable code thereon which identifies the promotion carrier ... and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product, i.e. the card of Day et al. does not carry promotions. Clearly, as Day et al. does not have a promotion on a promotion carrier, Day does not determine if a promotion on a promotion carrier is valid or not.

To expedite prosecution, independent claims 40 and 47 are amended to more clearly recite subject matter of the present invention, Amended independent claim 40 recites:

A system for providing promotions comprising:
a printed promotion carrier which carries information corresponding to a plurality of promotions for sale of a product, the promotion carrier having a machine readable code thereon which identifies the promotion carrier and a respective specific customer identifier corresponding to the identified promotion carrier, the respective specific customer identifier corresponding to a specific customer pre-selected to receive the printed promotion carrier, each promotion being associated with a product, each product having a machine readable product code and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product;

a reading device capable of reading the machine readable code and machine readable product codes, and configured to provide a data signal bearing information indicative of the identity of the promotion carrier, the identify of the specific customer and the identity of a plurality of selected products; and

a computer facility capable of receiving the data signal and configured to determine if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products, wherein

the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading device, and the computer facility determines if there are valid promotions contained on the promotion carrier by determining if a promotion on the promotion carrier has already been presented in a completed transaction, and - identifying the promotion as a valid promotion if it has not already been presented in a completed transaction.

Amended independent claim 47 recites:

A method for providing promotions comprising:

reading information from a machine readable code on a printed promotion carrier which carries information corresponding to a plurality of promotions for sale of a product, the machine readable code identifying the promotion carrier and a respective specific customer identifier corresponding to the identified promotion carrier the respective specific customer identifier corresponding to a specific customer pre-selected to receive the printed promotion carrier, each promotion on the promotion carrier being associated with a product, and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product;

reading machine readable product codes of one or more selected products, the product codes identifying an associated selected product;

providing a data signal bearing information indicative of the identity of the promotion carrier, the identify of the specific customer and the identity of a plurality of selected products;

determining if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products based on information in the data signal; and

determining if a promotion on the promotion carrier has already been presented in a completed transaction, and identifying the promotion as a valid promotion if it has not already been presented in a completed transaction.

In addition, claim 46 is amended to more clearly recite subject matter of the invention also. Amended claim 46 recites:

The system of claim 40, wherein

when the computer facility receives the data signal bearing information indicative of the identity of the promotion carrier for a completed transaction, data regarding all products comprising the completed transaction are stored,

the system further comprising a data analysis facility which is configured to analyze the data signal and the data regarding all products comprising the completed transaction to determine predetermined aspects of the use of the promotion carrier including identities of each product of the completed transaction and at least one of the total charged amount for the completed transaction exceeding a predetermined value, each product of the completed transaction providing a profit exceeding a predetermined money amount and each product of the completed transaction providing a profit exceeding a predetermined percentage.

Claim 53 is amended similar to claim 46.

With respect to amended claims 47 and 53, none of the applied prior art references discloses or suggests determining predetermined aspects of the use of the promotion carrier

including identities of each product of the completed transaction *and at least one of the total charged amount for the completed transaction exceeding a predetermined value, each product of the completed transaction providing a profit exceeding a predetermined money amount and each product of the completed transaction providing a profit exceeding a predetermined percentage.*

In view of the above, claims 40, 41, 46-48 and 53, as amended, are patentable over Smith et al., Day et al. and Blank considered alone or in combination. Accordingly, the allowance of claims 40, 41, 46-48 and 53 is respectfully solicited.

II. Claims 42, 45, 49 and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Day et al. and further in view of Blank and De Lapa (USPN 5,353,218).

However, as amended independent claims 40 and 47 are patentable over Smith et al., Day et al. and Blank, claims 42, 45 depending from amended claim 40, and claims 49 and 52 depending from amended claim 47 are patentable over Smith et al., Day et al. and Blank also, even when considered in view of De Lapa.

CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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